

Agilent Ref: 10004415-1
United States Application Serial No. 09/740,660

REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-5, 10, 13-21, 23-25, 27, and 32-49, the only claims pending and currently under examination in this application.

Formal Matters

Claim 32 has been amended to clarify the claim language, support for the amendment being found in the original claim language. Claim 1 has been amended to recite that the polymeric matrix is a synthetic matrix, support for this amendment being found in the specification at page 6, line 10. Claim 1 has also been amended to remove the objected to phrase. In addition, the dependency of Claim 37 has been amended to make Claim 37 dependent on Claim 36. Claim 1 has been amended to incorporate the limitations of Claims 8 and 11, and Claims 8 and 11 have been correspondingly canceled. Finally, amendments have been made to certain dependent claims in view of the cancellation of Claim 8. As, no new matter has been added by the above amendments, their entry by the Examiner is respectfully requested.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 32 has been rejected under 35 U.S.C § 112, second paragraph for asserted lack of antecedent basis. In view of the above amendment to Claim 32, this rejection may be withdrawn.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 1-5, 8, 10, 11, 13-27, 23-27, and 32-49 have been rejected under 35 U.S.C § 112, first paragraph, for allegedly failing to comply with the written description requirement. Specifically, the Office asserts that the written support is lacking for the phrase "polymeric matrix" and that the claim must be limited to recite "synthetic polymeric matrix." Solely in order to expedite prosecution of the present

Agilent Ref: 10004415-1
United States Application Serial No. 09/740,660

application and without in any way agreeing with the position of the Examiner, the Applicants have amended the claim to recite a "synthetic polymeric matrix." In view of this amendment, this rejection may be withdrawn. The Applicants expressly reserve the right to pursue a claim that recites "polymeric matrix" in a continuation application.

Claims 1-5, 8, 10, 11, 13-27, 23-27, and 32-49 have been rejected under 35 U.S.C § 112, first paragraph, for allegedly failing to comply with the written description requirement. Specifically, the Office asserts that the written support is lacking for the phrase "capable of emitting energy" and that the claim must be limited to recite "a donor molecule." In view of above amendment Claim 1, this rejection may be withdrawn.

Rejection under 35 U.S.C. § 1.75

Claim 37 has been rejected as being a substantial duplicate of Claim 34. In view of the above amendment to Claim 37, this rejection may be withdrawn.

Rejection under 35 U.S.C. § 102(b)

Claims 1-5, 8, 15-19, 21, 25, 27 and 32-39 and 47 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,372,745. Claim 1 has been amended to include the limitation of Claim 8, such that the fluorescent molecule must be an organometallic complex.¹

It must first be noted that U.S. Patent No. 4,372,745 never teaches a composition of matter having the claimed sturture, where a matrix is coated with a layer that includes an organometallic compound, which structure is further coated with a protective layer. U.S. Patent No. 4,372,745 fails to teach such a composition for at least the reason that the dye in the cited Example XX is no an organo metallic

¹ It is noted that this amendment has been made solely in order to expedite prosecution of the present application and without in any way agreeing with the position of the Examiner. The Applicants reserve the right to pursue claims of the scope prior to this amendment in a continuation application.

Agilent Ref: 10004415-1
United States Application Serial No. 09/740,660

matrix. As such, for at least this reason U.S. Patent No. 4,372,745 fails to anticipate the claimed invention.

Furthermore, U.S. Patent No. 4,372,745 lists a multitude of different types and classes of compounds, with organometallic complexes being only one type of a numerous number of these different types and classes of fluorescent compounds. In addition, there are numerous different structures disclosed in 4,372,745, only one of which is the structure taught in Example XX. For example, other disclosed structures include a solution of a fluorescent compound encased in a liposome.

As such, to arrive at the invention claimed in the present application, one would have to pick and choose among the multitude of different types of dyes and the multitude of different structures to arrive at the claimed invention, without having any specific motivation to do so. In the absence of providing this specific motivation, U.S. Patent No. 4,372,745 further fails to anticipate the claimed invention.

Therefore, Claims 1-5, 8, 15-19, 21, 25, 27 and 32-39 and 47 are not anticipated by U.S. Patent No. 4,372,745 under 35 U.S.C. § 102(b) and this rejection may be withdrawn.

Finally, Claims 1-5, 8, 15-19, 21, 25, 27 and 32-39 and 47 have been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 6,528,165. Upon review of the cited reference, it is not seen where the cited reference specifically discloses organometallic complexes as fluorescent dyes in a structure as claimed in the present application, as reviewed above. While a large number of different types of dyes are disclosed in this cited reference, there is no specific structure seen that matches the structure as claimed in the present application. As such, the cited reference fails to anticipate the claimed subject matter and this rejection may be withdrawn.

Agilent Ref: 10004415-1
United States Application Serial No. 09/740,660

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: September 13, 2004

By: 

Bret Field
Registration No. 37,620